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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,577	03/18/2004	Bandarpalle B. Shankar	IN06009US01	5973

24265 7590 04/30/2007  
SCHERING-PLOUGH CORPORATION  
PATENT DEPARTMENT (K-6-1, 1990)  
2000 GALLOPING HILL ROAD  
KENILWORTH, NJ 07033-0530

EXAMINER

DAVIS, ZINNA NORTINGTON

ART UNIT	PAPER NUMBER
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1625

MAIL DATE	DELIVERY MODE
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04/30/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/803,577

Applicant(s)

SHANKAR ET AL.

Examiner

Zinna Northington Davis

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23, 30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-9, and 11 is/are rejected.
- 7) ☒ Claim(s) 2, 10, 12-18, 21-23, 30 and 31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-23, 30, and 31 are pending.
2. Claims 19 and 20 have been withdrawn from consideration.
3. Claims 24-29 and 32-57 have been canceled.
4. Based upon the response filed February 8, 2007, the rejection under 35 U.S.C. 102 (b) based upon Kozlowski et al has been withdrawn.

#### **Response to the Restriction/Election of Species**

5. In the response filed February 8, 2007, Applicants again traverse the restriction and election of species requirement.

6. Applicants request that claims 19 and 20 be rejoined into the elected Group I.

It is the Examiner's position:

- Claim 1 is presented is not allowable.
- As such, the claims shall not be rejoined.

7. Applicants state that due to the commonality, a complete examination of claims 1-23, 30 and 31 would not cause undue burden.

It is the Examiner's position:

- The invention of claim 1 lacks a common core.
- The election of species requirement is maintained.
- However, the search of the elected species will be extended beyond the elected subject matter. See MPEP § 803.02.
- The undue burden is the examination of multiple and plural inventions within the compound of claim 1.

Art Unit: 1625

8. Applicants state that they further believe that the same art search will most probably apply to the alleged separate inventions and respectfully submit that the restriction is improper.

It is the Examiner's position:

- The instant claims are Markush claims. The radicals defined by  $R^1$ ,  $L^1$ ,  $L^2$ ,  $M^1$ ,  $M^2$  and Z are independent and patentable distinct.
- A prior art reference wherein  $M^2$  represent aryl would anticipate nor render obvious another radical such as cycloalkyl.
- Based upon the remarks, until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.
- The restriction requirement and election of species will be maintained.

9. The examined subject matter is as follows:

A compound of formula I wherein  $L^1 = O$  and S;  $L^2 = C, S,$  and O;  $M^1 =$  aryl and cycloalkyl;  $M^2 =$  aryl;  $p = 0$ ; and  $q = 0$ . The radicals not defined herein are as defined in claim 1.

10. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Art Unit: 1625

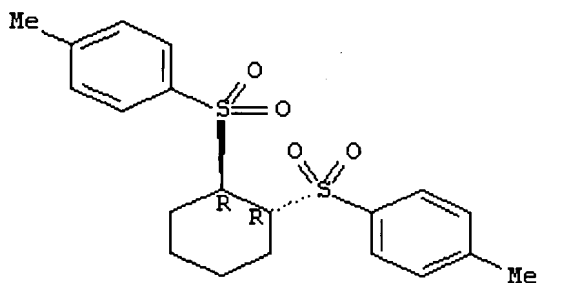
11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 3-9, 11, 23, 24, and 31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Truce et al (Reference U, cited by the Examiner).

The instantly claimed compound is disclosed. At page 4642, 2<sup>nd</sup> column, Experimental, 5th paragraph, see the named compound, cis-1,2 bis -(p-tolylsulfonyl)-cyclohexane, which is depicted below:



The claimed compound is fully met when L<sup>1</sup> and L<sup>2</sup>= S(O)<sub>2</sub> and O; M<sup>1</sup>= cycloalkyl; M<sup>2</sup> = aryl and R<sup>1</sup> is present.

13. Claims 2, 10, 12-18, 21-23, and 30-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 1625

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

15. This application contains claims drawn to an invention nonelected with traverse in the Response filed February 8, 2007. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

16. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zinna Northington Davis whose telephone number is 571-272-0682. The examiner can normally be reached on M-F.

18. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Art Unit: 1625

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**Zinna Northington Davis**  
**Primary Examiner**  
**Art Unit 1625**

Znd  
04.25.2007